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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,802	02/17/2004	Stanislaw Kielbowicz	015258-062800US	1519
20350 7590 02/17/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER PALABRICA, RICARDO J				
ART UNIT 3663		PAPER NUMBER		
MAIL DATE 02/17/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/780,802

Applicant(s)

KIELBOWICZ, STANISLAW

Examiner

Rick Palabrica

Art Unit

3663

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/6/10.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Applicant's 1/6/10 Amendment, which directly amended claim 12, added new claim 17, and traversed the previous examiner's rejection of claims in the 7/6/09 Office action, is acknowledged.

Applicant's arguments have been fully considered by the current examiner but they are not persuasive.

Response to Arguments

2. Applicant traversed the applied art on the grounds that: a) "Kielbowicz discloses only two spaced apart walls in each cassette unit but no intermediate walls between spaced apart walls"; b) "Rivers also fails to disclose that 'the cassette units each contain spaced apart walls and one or more intermediate walls arranged between and apart form the spaced apart walls.'"

The current examiner disagrees.

As to argument a), the previous examiner reads applicant's claim language, "intermediate walls" on adjacent paired walls 11, 12 (see page 11 of the 7/6/09 Office action). Fig. 2 of Kielbowicz shows three of these intermediate walls having a space "B" between them and each of the paired walls being separated by spacers 21, 22. As to the claim language, "two spaced apart walls" this limitation reads on flange 4 and end plate 5 (see Figs. 1 and 2). Note that the intermediate walls (i.e., the three paired walls 11, 12) are disposed between the two spaced apart walls (i.e., elements 4 and 5).

As to argument b), the previous examiner does not rely upon Rivers for the teaching that applicant alleges to be lacking in Kielbowicz. Instead, Rivers is applied to provide a teaching on the "cassette units having rectangular sides." See page 11 of the 7/6/09 Office action.

Applicant's arguments are unpersuasive because the applicant has not shown that the references do not teach what the previous examiner has stated they teach.

3. Applicant traversed applied art, Rivers, on the grounds that: a) "the filter housing and assembly disclosed by Rivers" is for an application that is different from the claimed invention; b) "[t]here is no indication by Rivers that the disclosed filter is suitable for high pressure liquid filtering"; c) "[t]he filter housing and assembly disclosed by Rivers is further unsuitable for use in an emergency cooling system of a nuclear because the pressure drop created by the porous bed absorption would be excessive."

The current examiner disagrees.

As to argument a), applicant's argument appears to be based on the application of the claimed invention that is recited in the preamble of claim 1, i.e., "for screening off a suction space and a suction duct connect to it, in an emergency cooling system of a nuclear power plant."

The current examiner notes that the claims are directed to an apparatus and NOT to a process. The clause, which applicant uses as basis of his traverse, is a statement of intended or desired use. This clause, as well as other statements of intended use in the claims, does not serve to patently distinguish the claimed structure

over that of the reference, as long as the structure of the cited references is capable of performing the intended use. See MPEP 2111-2115.

See also MPEP 2114 that states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531.

[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

The system in the cited reference is capable of being used in the same manner and for the intended or desired use as the claimed invention. Note that it is sufficient to show that said capability exists, which is the case for the cited reference.

As to argument b), to what pressures does the so-called "high pressure" refer? Applicant's argument has no probative value because it is vague, indefinite and incomplete. The term "high pressure" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the argument.

Notwithstanding the indefiniteness of the term relied upon by applicant in his argument, note that River's filter, which is used in nuclear power plants, can withstand high pressures, as evidenced by the following:

"The present invention recognizes that in various applications, for example, in the treatment of an effluent fluid stream from nuclear reactor installations, an adsorbent material is provided to receive the stream of effluent material. This adsorbent or filtering material must be capable of

adsorbing impurities carried by such effluent while withstanding unusual operating characteristics such as high pressure, temperature, or an increased fluid flow rate." Underlining provided. See col. 1, lines 31+.

As to argument c), the teaching in Rivers applied by the previous examiner to amend Kielbowicz is NOT based on the "porous bed adsorption media" in Rivers, but rather on the rectangular configuration of the Rivers filter. Applicant's arguments are unpersuasive because the applicant has not shown that the references do not teach what the previous examiner has stated they teach, nor, has the applicant shown that the previous examiner's reasoning for and manner of combining the teachings of references is improper or invalid.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kielbowicz (U.S. 5,759,398) in view of Rivers (U.S. 4,049,406).

As to claims 1 and 3-16, the reasons are the same as those stated in the 7/6/09 Office action, as further clarifies in sections 2 and 3 above, which reasons are herein incorporated.

As to claim 17, applicant's claim language reads on Kielbowicz as follows: a) "outflow side" reads on the flange side having an aperture leading to suction chamber 6; b) "suction side" reads on the end plate side that is closed

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:00-4:30, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rick Palabrica/
Primary Examiner, Art Unit 3663

February 7, 2010